

REMARKS

By this paper, Applicant has cancelled claim 28, and amended claims 21, 22 and 29. Applicant has not added any claims. The independent claims remain claims 21 and 22. This amendment contains no new matter. Entry of this amendment is respectfully requested.

Claim Rejections – 35 USC § 103

Examiner's Section 2. Claims 21-22, 28-29 and 36

The Examiner has maintained the rejection of claims 21-22, 28-29 and 36 under 35 USC § 103 as being unpatentable over Minutoli et al., U.S. Patent No. 3,782,061 ("Minutoli") in view of Commins 459414913 C5 ("Commins") and Siemons, U.S. Patent No. 5,839,981 ("Siemons").

Applicant still maintains and repeats its argument that it is not appropriate to combine Minutoli with Commins and/or Siemons. Applicants believe the Examiner has failed to make a prima facie case of obviousness, given the teachings of Minutoli.

Minutoli teaches away from making the combination suggested by the Examiner. Furthermore, neither Commins or Siemons suggest modifying Minutoli in a way that would read on the invention as claimed. As such, the references do not suggest the combination.

Minutoli teaches an invention that "allows a multistoried building to be uniformly prestressed throughout in a simple manner, while avoiding the delay occasioned by the need to prestress the reinforcing rods corresponding to a single story of a building." Minutoli, column 1, line 18.

Minutoli is concerned with "post-tensioning and interlocking assembly of the entire structure." Minutoli, column 1, line 43. Minutoli is mainly concerned with the compression states between the first panels 12 and 14 – the vertical building panels in his drawings, and the second panel 16 – shown as the floor panel in the drawings. As Minutoli, says, "After construction 10 is fully erected, nuts 60 are put into place and tightened to tension the respective rod strings so that a uniform prestressing of the various first and second panels is achieved." Minutoli, column 4, line 34.

Minutoli is not concerned with the expansion of his bushings 42 and 50 and his sleeve 50 to keep his reinforcing rod in tension. Yet the Examiner makes the argument that the sleeve and bushings, correspond to the expansion device of the present invention, and by adding a spring between the bushings 42 and 50, Minutoli corresponds to the present invention.

However, it is not proper to add an element to a reference, if the reference itself teaches away from adding such an element.

Minutoli, teaches away from a critical feature of the invention, the ability of the bearing members to further move out of the surrounding sleeve once the expansion sleeve is compressively loaded, when Minutoli says, "Where independent adjustment of the bushing relative to sleeve 42 is not essential, bushing 48 and 50 can be formed as an integral unit with sleeve 42." Minutoli, column 3, line 49. Later Minutoli goes on to say, "In some cases, it will be desirable to pressure grout the void space within conduit 2 around the reinforcing rod." Minutoli, column 4, line 49. By teaching that it can be desirable to weld the bushings and the sleeve together, Minutoli clearly shows that he would not see the use of adding a spring to his invention between the bushings. Furthermore, by teaching that it is desirable to fill the space around the rod with grout, Minutoli is teaching that it is not desirable to have his bushings 42 and 50 move in relation to sleeve 48 once the reinforcing rod is placed in tension.

In fact Minutoli, not only teaches filling the spaces around the reinforcing rod with grout to prevent the components from moving, Minutoli actually teaches disposing of his reinforcing rod and what would be equivalent to welding the fastening member, the expansion device and the resisting member of the present invention together, which clearly is not the claimed invention. Minutoli, at column 4, line 55 says, "In some case, where metal brackets are employed, the reinforcing rods (or cable) may be eliminated and the metal portions welded together." All of the drawings of Minutoli show metal brackets being employed and the invention is only discussed in conjunction with the use of metal brackets.

Applicant also still maintains that Minutoli teaches away from the present invention, because, in Minutoli, it is possible for Minutoli's bushing 48, which the Examiner argues corresponds to the first bearing member of the present invention to not support anything, and the claims of the present invention clearly call for the the first bearing member to support the fastening member.

The members of Minutoli that the Examiner describes as corresponding to the fastening member of the present invention are plate 26, nut 60 and "the part

next to part 59 figure 2". In Minutoli, these members are shown placing not only bushing 48 in compression but also panel 16. Because the fastening member of Minutoli rests not only on bushing 48, but panel 16, there can be situations when the fastening member of Minutoli places no compression on bushing 48.

Similarly, Minutoli teaches away from the present invention, because in Minutoli, it is possible for what the Examiner says corresponds to the second bearing member of the present invention to not rest on what would be the resisting member of Minutoli – upper anchor plate 24. The claims of the present invention clearly call for the second bearing member to rest on the resisting member. If bushing 50 of Minutoli was the only member contacting first panel 12, and thus bushing 50 carried the entire weight of second panel 16 and first panel 14, I believe Minutoli would consider this an undesirable situation. See Minutoli where he says, "In addition, it will be apparent to those skilled in the art that various form of compressible or non-compressible grouting may be employed between abutting portions of the panels." Minutoli, column 4, line 51.

Minutoli's bushings 48 and 50 together with the beveled surfaces of anchor plates 24 and 26 are used as guides to fit first panels in corresponding relationship with second panels. See Minutoli at column 3, beginning at line 52. This guiding function, while it can be achieved with engagement between the bushings 48 and 50 and anchor plates 24 and 26 does not require it when Minutoli's reinforcing rod is placed in tension.

Applicant also notes that the Examiner is still describing the arrangement of parts in Minutoli in a manner that teaches away from the present invention, and, in fact, Applicant has amended claims 21 and 22 so that such a reading of Minutoli is now in clear contradiction of the claims.

At page 2 of the Office Action, 8 lines up from the bottom of the page, the Examiner states that Minutoli teaches a "fastening member [that] is only directly supported by the expansion device and said elongated tension member..." This statement could only be correct if the Examiner treats second panel 16 as part of the expansion device of the present invention. Applicant now believes that the Examiner was in fact treating the second panel 16 as part of the expansion sleeve, given the Examiner's comment on the last line of page 8, that "the claim language is not exclusive."

In Minutoli, second panel 16 and sleeve 42 are in fact connected. As Minutoli says, "Each second panel 16 is provided with an internally threaded sleeve 42..." Minutoli at column 3, line 36.

Applicant has now amended claims 21 and 22, so that the description of the expansion device cannot be read as including Minutoli's building panel 16.

In particular, Applicant has amended the claims to state that the elongated tension member and the resisting member are connected to the structural frame of the building, but that the fastening member and the expansion device are only connected to the structural frame of the building by the attachment of the fastening member to said elongated tension member and by the receipt by the expansion device of the elongated tension member there through and by the contact of the expansion device with the resisting member. This allows for the increasing of the height of the expansion member.

In comparison, in Minutoli, such increasing of the overall length of the bushing and sleeve combination of Minutoli would not be desirable after the elongated tension rod is placed in tension, and is not likely to be even possible with the addition of the springs of Commins or Siemons, given that the spring would have to push bushings 48 and 50, and lift either first panel 14 or first panel 14 and second panel 16.

No new matters is introduced by the amendments of claims 21 and 22. Support for much of the amendment is found in cancelled claim 28, at page 7, beginning at line 35, and in the drawings.

Applicant by these arguments and this amendment, feels it has overcome the rejection raised by the Examiner of claims 21 and 22, and respectfully requests that the Examiner allow the claims. As claims 29 and 36 depend from claim 22, Applicant feels they too are now in condition for allowance.

With respect to Claim 23, although it appears that the Examiner has allowed the claim, the Examiner still seems to argue at page 3, line 12 that claim 23 is obvious. Applicant maintains Minutoli cannot teach opposite threading (see also page 9, line 3 of the Examiner's most recent Office Action). Minutoli represents threaded portions of the members of Minutoli only schematically. It is not possible to determine the orientation of the threaded members as the Examiner has done. While it is true that bushings 48 and 50 of Minutoli thread into opposite ends of the sleeve as the Examiner described, that is not the same as thread of the surrounding sleeve being threaded in opposite direction to the thread of the elongated tension member.

Furthermore, with respect to claim 29, which calls for the building to have a structural frame at least a portion of which is made from wood, Applicant renews its argument. While it is true that wood is a common building material. Wood behaves in a different way than concrete which is the relevant aspect of the

limitation in the claims. Wood shrinks as is described in the application as filed at page 1, line 22, something which Minutoli is silent about.

The concrete panels 12, 14 and 16 of Minutoli that the string of reinforcing rods compress are relatively uncompressible members, in comparison to wood framed panels that are expected to shrink. Thus, a structural frame that is at least partially made from wood will have need for this invention, as compared to a building made from concrete panels.

Examiner's Section 3. Claim 24

The Examiner has rejected claim 24 under 35 USC § 103(a) as unpatentable over Minutoli in view of Commins and Siemons as applied to claim 22 and further in view of Greenwood, 459417970 page 318, figure 19 ("Greenwood").

Claim 24 depends from claim 22, and Applicant by the arguments and the amendment made above, feels it has overcome the rejection raised by the Examiner of claim 22. Those arguments and amendment apply equally to claim 24 as it incorporates all of the limitations of claim 22 and Applicant raises them here without repeating them for the sake of brevity. As such, Applicant believes claim 24 is in condition for allowance.

Examiner's Section 4. Claim 25

The Examiner has again rejected claim 25 under 35 USC § 103(a) as unpatentable over Minutoli in view of Commins and Siemons.

Claim 25 depends from claim 22, and Applicant by the arguments and the amendment made above, feels it has overcome the rejection raised by the Examiner of claim 22. Those arguments and amendment apply equally to claim 25 as it incorporates all of the limitations of claim 22 and Applicant raises them here without repeating them for the sake of brevity. As such, Applicant believes claim 25 is in condition for allowance.

Furthermore, the Examiner still maintains that element 28 of Minutoli corresponds to the locking clip of claim 25, and could be modified to meet all of the limitations of claim 25. Applicant still respectfully disagrees. The Examiner has still not made a prima facie case of obviousness, because the Examiner still incorrectly described the relationship of the parts. Element 28 of Minutoli is attached to anchor plates 24 and 26 which the Examiner characterizes as being part of the fastening member of the present invention. These plates are bearing

plates, but they are not equivalent to the bearing members of the present invention which are part of the expansion device. Element 28 would prevent plate 26 from rotating, but it would not prevent bushings 48 and 50 from rotating and moving out of the sleeve 42.

Applicant also fails to see in Minutoli any motivation to make elements 28 threadably releasable from plate 26, since they will be embedded in concrete. Since Minutoli shows plate 26 having two elements 28, it would not be possible to threadably release the plate 26 from both of them after they were embedded in the concrete.

Examiner's Section 5. Claim 26

The Examiner has rejected claim 26 under 35 USC § 103(a) as unpatentable over Minutoli in view of Commins and Siemons as applied to claim 22 and further in view of Fuehrer, U.S. Patent No. 3,118,681 ("Fuehrer").

Claim 26 depends from claim 22, and Applicant by the arguments and the amendment made above, feels it has overcome the rejection raised by the Examiner of claim 22. Those arguments and amendment apply equally to claim 26 as it incorporates all of the limitations of claim 22 and Applicant raises them here without repeating them for the sake of brevity. As such, Applicant believes claim 26 is in condition for allowance.

Examiner's Section 6. Claim 27

The Examiner has rejected claim 27 under 35 USC § 103(a) as unpatentable over Minutoli in view of Commins and Siemons as applied to claim 22 and further in view of Greenwood.

Claim 27 depends from claim 22, and Applicant by the arguments and the amendment made above, feels it has overcome the rejection raised by the Examiner of claim 22. Those arguments and amendment apply equally to claim 27 as it incorporates all of the limitations of claim 22 and Applicant raises them here without repeating them for the sake of brevity. As such, Applicant believes claim 27 is in condition for allowance.

Allowable Subject Matter

The Applicant would like to thank the Examiner for indicating that claims 23, 30 – 35 and 37 – 39 would be allowable, if written in independent form.

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Applicant has not amended these claims at this time. Applicant hopes the Examiner will now consider these claims allowable based on the amendment and arguments raised with respect to claims 22 from which these claims depend.

Conclusion

Applicant believes the claims are currently in condition for allowance and respectfully requests the same.

Please direct any calls in connection with this application to the undersigned at (510) 832-4111.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read 'C.R. Cypher', is written over a horizontal line.

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